



1

AF  
JF

**UNITED STATES PATENT AND TRADEMARK OFFICE**

Examiner: Gary K. Graham

Art Unit: 1744

*In re:*

Applicant: Thomas KOTLARSKI

Serial No.: 09/674,447

Filed: December 26, 2000

**BRIEF ON APPEAL**

October 12, 2006

Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 2313-1450

Sir:

This communication is responsive to the Order Returning  
Undocketed Appeal to Examiner.

In the Office Action from the U.S. Patent and Trademark  
Office, it was indicated that the Brief on Appeal did not correspond to new  
rules under 37 CFR paragraph 41.37 (c).

The explanations in the Office Action has been gratefully  
acknowledged. In connection with this, ~~a new Brief on Appeal is~~

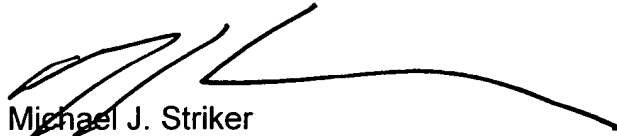
1

I hereby certify that this correspondence is being  
deposited with the United States Postal Service  
as first class mail in an envelope addressed to:  
Commissioner for Patents, P.O. Box 1450,  
Alexandria, VA 22313-1450.  
On 10/12/06

submitted herewith, which has been drafted in accordance with the new rules.

It is respectfully requested to review the enclosed Brief on Appeal and to continue the prosecution.

Respectfully submitted,

A handwritten signature in black ink, consisting of several fluid, overlapping strokes that form a stylized representation of the name Michael J. Striker.

Michael J. Striker  
Reg. No. 27233  
103 East Neck Road  
Huntington, NY 11743  
(631)549-4700



**UNITED STATES PATENT AND TRADEMARK OFFICE**

Examiner: Gary K. Graham

Art Unit: 1744

*In re:*

Applicant: Thomas KOTLARSKI

Serial No.: 09/674,447

Filed: December 26, 2000

**BRIEF ON APPEAL**

October 12, 2006

Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 2313-1450

Sir:

This is an appeal from the final rejection of claims 2-6, 8-13,  
16 and 17 by the Primary Examiner.

I hereby certify that this correspondence is being  
deposited with the United States Postal Service  
as first class mail in an envelope addressed to:  
Commissioner for Patents, P.O. Box 1450,  
Alexandria, VA 22313-1450.  
On 10/12/06  
[Signature]

### Real Party of Interest

The real party of interest is Robert Bosch GmbH, having a business address of Postfach 30 02 20, D-70442 Stuttgart, Germany.

### Related Appeals and Interferences

The other are no pending appeals, interferences, or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

### Status of Claims

In the Final Office Action, the Examiner indicated that claims 18 and 19 were allowed by him.

Claims 2-6, 8, 9, 16 and 17 were rejected under 35 U.S.C. 103(a) over the German patent to Merkel, et al in view of the U.S. patent to Rosen.

Claims 2-6, 8-11, 16 and 17 were also rejected under 35 U.S.C. 103 over the German patent to Merkel in view of the U.S. patent to Oishei.

Claims 12 and 13 were rejected under 35 U.S.C. 103(a) over the German patent to Merkel in view of the U.S. patents to Oishei and Samartgis.

Claim 16 and 17 were also objected to.

#### Status of Amendments

After the Final Office Action, the appellant's filed a Request for Reconsideration on August 18, 2005.

In the Advisory Action of August 31, 2005, the Examiner indicated that the objections to claims 16 and 17 were overcome, claims 18 and 19 were allowed, and claims 2-6, 8-13, 16 and 17 were still rejected. The Examiner entered the Request for Reconsideration.

#### Summary of Claimed Subject Matter

The present invention deals with a wiper blade for window panes in motor vehicles.

In accordance with the present invention as defined in claims 16 and 17 the wiper blade has an elongated rubber-elastic wiping strip 20 connectable with a window pane and having two longitudinal sides in which open-edged longitudinal receiving grooves 32 are arranged in a

plane approximately parallel to the window pane. The wiping strip also has a longitudinal web 36 provided between bases of the receiving groove 32.

The wiping blade further has a carrying element with two strip-shaped elongated, resilient carrying rails 12 which are accommodated in the grooves 32, so that the wiping strip 20 is located directly on a lower side of the carrying rails 12. A connection device is provided for a wiper arm, which is a part of the carrying element and in a middle region it is arranged directly on an upper side of the carrying rails 12. The carrying rails are secured in the receiving grooves 32 transversely to their longitudinal extension with L-shaped claws. A first leg 48 of each L-shaped claw traverses outer edges 52 of the carrying rails 12, while a second leg 50 engages under the respective carrying rail.

A distance 60 which is measured transverse to a longitudinal extension of the wiper blade 10 between facing inner edges of the first leg 48 is less than a sum of a width 62 of the two carrying rails 12 plus a width of the longitudinal web 36 of the wiper strip 20. The wiper strip 20 therefore is held by a compression produced in the web in the middle region of the wiper blade under the connection device relative to the carrying element.

These features are defined both in claim 16 which defines a wiper blade for window panes in motor vehicles, and in claim 17 which defines a wiper system for window panes which includes a wiper arm and a wiper blade formed as defined in claim 16. They are described on pages 4-8 of the specifications and shown in Figures 1-9 of the drawings.

Grounds of Rejection to be Reviewed on Appeal

The Examiner rejected claims 2-6, 8, 9, 16 and 17 under 35 U.S.C. 103(a) over the patent to Merkel in view of the patent to Rosen.

The Examiner also rejected claims 2-6, 8-11, 16 and 17 under 35 U.S.C. 103(a) over the patent to Merkel in view of the patent to Oishei.

Claims 12 and 13 were rejected under 35 U.S.C. 103(a) over the patent to Merkel in view of the patents to Oishei and Samartgis.

Thus, these are the grounds to be reviewed on appeal. In particular, it is necessary to review whether the rejection of claims 2-6, 8, 9, 16 and 17 as being obvious over the combination of the patents to Merkel and Rosen, and the rejection of claims 2-6, 8-11, 16 and 17 as being obvious over the combination of the patents to Merkel and Oishei can be considered as justifiable. Also, it should be reviewed whether the

rejection of claims 12 and 13 as being obvious over the patents to Merkel, Oishei, and Samartgis should be considered as justifiable.

#### Argument

a. Arguments related to the Examiner's rejection of the claims over the patent to Merkel in view of the patent to Rosen.

The German patent to Merkel discloses a so-called hinge-free wiper blade, in which the supporting element is composed of two spring rails located in longitudinal grooves of the wiper blade and held there by clamps. As specifically stated in column 3, starting from line 27 of this reference:

“By target-oriented compression of the clamps, a certain deformation of the wiper arm body 22 is obtained, whereby a securing of the supporting element 12 on the wiper strip and a securing of the clamps 50 which belong to the supporting element 12 on the wiper strip is obtained”.

The clamps 50 are however explicitly arranged on the ends of the supporting element as explained in column 3, starting from line 9.

“The two clamps 50 which in the shown embodiment are formed identical belong to the supporting element 12, and they are arranged on both ends of the wiper strip 14 and connect the neighboring ends of the longitudinal rails in pairs with one another.”



Nowhere in this reference is disclosed that the intermediate clamps 60, on which the connection device 66 is arranged, must be used to hold the wiper strip by a compression on the support element. This type of mounting was limited until now always to the ends of the supporting rails or longitudinal rails, which is shown in the U.S. patents to Rosen and to Oishei.

With the special type how to insert the wiper strip with its longitudinal rails into the supporting bracket frame, a person of ordinary skill in the art who familiarized himself with the patent to Merkel can only obtain the teaching to use the end claws of the supporting bracket system to produce a certain pressure. The sections cited by the Examiner can not be changed so that the cam-shaped structure however can be repeated on other locations on the longitudinal rails. This structure would correspond closer to the inner projections claimed in the present application, as can be seen in Figures 7-9. As explained in column 2, starting from line 61, such a structure reinforces the sheet and changes the elastic properties in such regions, so that a person skilled in the art would keep away such cams along the supporting element, since local reinforcement in the wiper blades without supporting bracket frame must be avoided.

It therefore follows that a person skilled in the art would not combine the teachings of the patents to Merkel and Rosen to arrive at the present invention defined in claims 16 and 17.

b. Arguments related to the Examiner's rejection of the claims over the patent to Merkel in view of the patent to Oshei.

From the patent to Oishei a person of ordinary skill in the art can obtain a teaching to provide compression on the ends of the wiper strip and the support element, and in this reference a supporting bracket frame and the claw brackets connected with it are utilized. Since this reference deals with a so-called refill solution in which subsequently a wiper strip together with its longitudinal rails is introduced into an available supporting bracket frame, it is not possible to use a central claw of a claw bracket for carrying out the compression. The wiper strip would then be no longer insertable from its end.

It is therefore believed to be clear that the combination of the patent to Merkel with the patent to Oishei would also not lead to the applicant's invention.

c. Arguments related jointly to the rejection of the claims over the patent to Merkel in view of the patent to Rosen, and over the patent to Merkel in view of the patent to Oshei.

It is believed that the Examiner's opinion that the wiper blade defined in claims 16 and 17, in which the wiper strip with a hinge-free wiper blade without a supporting bracket frame is held by the special construction of the connection device by compression under the connection piece for the wiper arm, can be considered as a hindsight consideration of the Examiner who familiarized himself with the new features of the present invention as defined in these claims. The prior art does not disclose these features, and these features can not be derived from the prior art either taken singly or in combination with one another as a matter of obviousness.

The Examiner rejected the claims as being obvious over two combinations of the references. As shown herein above, the references did not teach the new features of the present invention as defined in claims 16 and 17, and these features can not be derived from the references taken singly or in combination with one another. Instead, in order to arrive at the applicant's invention from the references, the references have be fundamentally modified by including into them directly the new features of the present invention which are now defined in claim

16 and 17. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification. This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in re Randol and Redford (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Definitely, there is nothing in the references to suggest such significant modifications.

In view of the above presented arguments, it is believed that claims 16 and 17 should be considered as patentably distinguishing over the art and should be allowed.


As for dependent claims 2-6 and 8-11, these claims depend directly or indirectly on claim 16, they share its presumably allowable features, and therefore they should be allowed as well.

d. Arguments related to the Examiner's rejection of claims 12 and 13.

Claims 12 and 13 depend indirectly on claim 16, they share its allowable features and therefore they also should be allowed.

Reconsideration of the present application, reversal of the Examiner's rejection of the claims, and allowance of the present application is most respectfully requested.

Respectfully submitted,



Michael J. Striker  
Reg. No. 27233  
103 East Neck Road  
Huntington, NY 11743  
(631)549-4700

## CLAIMS APPENDIX

Claim 1 cancelled.

2. Wiper blade according to claim 16, wherein each of the two carrying rails (12) projects out of its receiving groove (32) at least along a longitudinal portion by an edge strip, and in that the second L-legs (50) engage the lower strip surface (19) of their carrying rails (12) which faces the window pane (14).

3. Wiper blade according to claim 16, wherein the holder (16) has a plate-shaped body (42) which is supported at the upper strip surfaces (13) of the carrying rails (12), the first L-legs (48) of the claws (46) being connected with longitudinal sides (44) of this plate-shaped body (42) that are located opposite one another.

4. Wiper blade according to claim 16, wherein the claws (46) are arranged at the longitudinal sides (44) by pairs located opposite one another.

5. Wiper blade according to claim 3, wherein the body (42) of the holder (16) is provided at its underside facing the upper strip

surfaces (13) of the two carrying rails (12) with a longitudinal cutout (54) for receiving a cover strip (40) of the wiping strip (20) defining the width of the two receiving grooves (32).

6. Wiper blade according to claim 16, wherein the holder (16) is provided with means (48) for connecting the wiper arm (18).

Claim 7 cancelled.

8. Wiper blade according to claim 16, wherein the holder (16) is made of plastic.

9. Wiper blade according to claim 16, wherein the holder (16) is made of metal.

10. Wiper blade according to claim 16, wherein each carrying rail (112, 212, 312, respectively) is provided with at least one projection (116, 216, 316, respectively) at its inner longitudinal edges (114, 214, 314, respectively) facing the longitudinal web (36) of the wiping strip (20).

11. Wiper blade according to claim 10, wherein in that the projection (116) of one carrying rail (112) is located opposite to the projection (116) of the other carrying rail (112).

12. Wiper blade according to claim 10, wherein the projection (216) of one carrying rail (212) is arranged so as to be offset with respect to the projection (216) of the other carrying rail (212) in its longitudinal direction.

13. Wiper blade according to claim 10, wherein a recess (318) of one carrying rail (312 or 313) is located opposite to the projection (316) of the other carrying rail (312 or 313).

Claims 14-15 cancelled.

16. A wiper blade for window panes in motor vehicles, comprising an elongated rubber-elastic wiping strip (20) contactable with a window pane and having two longitudinal sides in which open-edged longitudinal receiving grooves (32) are arranged in a plane approximately parallel to the window pane, with a longitudinal web (36) provided between bases of the receiving grooves (32); a carrying element having two strip-shaped elongated, resilient carrying rails (12) which are accommodated in the grooves (32) so that the wiping strip (20) is located directly on a lower



side of the carrying rails (12); a connection device for a wiper arm, which is a part of the carrying element and in a middle region is arranged directly on an upper side of the carrying rails (12), and the carrying rails being secured in the receiving grooves (32) transversely to their longitudinal extension with L-shaped claws, wherein a first L-leg (48) of each L-shaped claw traverses outer edges (52) of the carrying rails (12) and a second L-leg (50) engages under the respective carrying rail (12), wherein a distance (60) measured transverse to a longitudinal extension of the wiper blade (10) between facing inner edges of the first L-leg (48) is less than a sum of a width (62) of the two carrying rails (12) plus a width of the longitudinal web (36) of the wiping strip (20), so that the wiping strip (20) is held by a compression produced in the web in the middle region of the wiper blade under the connection device relative to the carrying element.

17. A wiper system for window panes of motor vehicles, comprising a wiper arm; and a wiper blade mountable on the wiper arm and including an elongated rubber-elastic wiping strip (20) contactable with a window pane and having two longitudinal sides, in which open-edged longitudinal receiving grooves (32) are arranged in a plane approximately parallel to the window pane, with a longitudinal web (36) provided between bases of the receiving grooves (32); a carrying element having two strip-shaped elongated, resilient carrying rails (12) which are accommodated in the grooves (32) so that the wiping strip (20) is located

directly on a lower side of the carrying rails (12); a connection device for a wiper arm, which is a part of the carrying element and in a middle region is arranged directly on an upper side of the carrying rails (12), and the carrying rails being secured in the receiving grooves (32) transversely to their longitudinal extension with L-shaped claws, wherein a first L-leg (48) of each L-shaped claw traverses outer edges (52) of the carrying rails (12) and a second L-leg (50) engages under the respective carrying rail (12), wherein a distance (60) measured transverse to a longitudinal extension of the wiper blade (10) between facing inner edges of the first L-leg (48) is less than a sum of a width (62) of the two carrying rails (12) plus a width of the longitudinal web (36) of the wiping strip (20), so that the wiping strip (20) is held by a compression produced in the web in the middle region of the wiper blade under the connection device relative to the carrying element.

## EVIDENCE APPENDIX

None

#### RELATED PROCEEDINGS APPENDIX

There are no decisions rendered by accord or the board in any proceedings pursuant to paragraph "Related Appeals and Interferences" of the Brief on Appeal".